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In re Application of:
Denise L. Faustman et al.
Serial No.: 10/775,487
Filed: February 10, 2004
Attorney Docket No.: 00786/457003

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: PETITION DECISION
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This is in response to the petition under 37 CFR § 1.181, filed on November 13, 2007, requesting withdrawal of finality of the Office action of September 13, 2007.

BACKGROUND

More recently, the examiner mailed a non-final Office action on December 15, 2006 setting a three month shortened statutory period for reply. In this Office action, claims 76-82 were pending, claims 78, 81 and 82 were withdrawn from consideration on the merits, and claims 76, 77, 79 and 80 were examined. The examiner rejected:

- 1) Claim 77 under 35 USC 112, first paragraph, lacking appropriate written description,
- 2) Claims 76, 77, 79 and 80 under 35 USC 112, first paragraph, for lacking enablement,
- 3) Claims 76, 77, 79 and 80 under 35 U.S.C. § 102(b) as anticipated by Satoh et al. (US 5,560,908) as evidenced by Hsu et al. (Cell. 1996 Jan26;84(2):299-308),
- 4) Claims 76, 77, 79 and 80 under 35 U.S.C. § 102(e) as anticipated by Faustman, D (U.S. Patent No. 6,660,487),
- 5) Claims 76, 77, 79 and 80 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,660,487,
- 6) Claims 76, 77, 79 and 80 , provisionally, on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-30, 65-73 and 91-108 of copending USSN 10/851,983, and

7) Claims 76, 79 and 80, provisionally, on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-52 and 82-90 of copending USSN 10/851,983.

In reply to the non-final Office action of December 15, 2006, applicants filed a response on June 20, 2007 which included remarks, an amendment to the specification and a Declaration filed by Inventor Denise L. Faustman. Subsequently, prior to the final Office action, Applicants filed two Information Disclosure statements; one on July 2, 2007 and one on August 24, 2007.

The examiner mailed a final Office action on September 13, 2007 setting a three month shortened statutory period for reply. In this Office action, claims 76-82 were pending, claims 78, 81 and 82 were withdrawn from consideration on the merits, and claims 76, 77, 79 and 80 were examined. In this Office action, the examiner maintained the following rejections:

- 1) Claims 76, 77, 79 and 80 under 35 USC 112 First paragraph for lacking enablement,
- 2) Claims 76, 77, 79 and 80 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,660,487 and
- 3) Claims 76, 77, 79 and 80 , provisionally, on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-30, 65-73 and 91-108 of copending USSN 10/851,983.

The examiner additionally instituted a new rejection over claims 76, 77 and 80 under 35 USC 102(b) as being anticipated by Jacob et al. (Proc Natl Acad Sci USA, 1990). It is pointed out that the examiner stated "Applicant's submission of the IDS of July 7, 2007 prompted the New Grounds of Rejection set forth below" (p. 10, final Office action). This is clearly a typographical error because the Jacob et al. reference was provided within the IDS filed by Applicants on July 2, 2007. Consequently, the examiner explicitly states in the conclusion of the final Office action that "Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 73 CFR 1.17(p) on July 2, 2007 prompted the new ground(s) of rejection presented in this Office action" (see p. 12, final Office action).

In response thereto, applicants filed this petition under 37 CFR § 1.181 on November 13, 2007, requesting withdrawal of finality of the Office action of September 13, 2007.

It is pointed out that applicants footnoted, in their petition, reference to an upcoming personal interview which was, in fact, held on November 19, 2007. In attendance at this interview were Denise Faustman, Paul Clark, Todd Armstrong, and examiners Michail Belyavskiy and Zachary Skelding. At this interview, the enablement and art rejections were discussed and the examiner explained his positions. This interview did not result in any change in the grounds of rejection of record, and therefore, did not influence the instant petition decision. The basis for the instant decision relies on the standing rejections and for the reasons of record as argued therein.

DISCUSSION

The petition and the file history have been carefully considered.

Applicants cite the MPEP § 706.07(a)

...the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of the rejection and objection....applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in prosecution of his or her application...

Applicants also cite the MPEP § 706.07(d):

[I]f, on request by application for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

Applicants further cite the MPEP § 706.07(e):

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn.

Applicants argue that the finality was premature because the "...[o]ffice has not given Applicant a 'full and fair hearing..[so that] a clear issue between applicant and examiner [can] be developed...before appeal'" (Applicant citing from the MPEP § 706.07(a)). Specifically, applicants contend that the data found in the declaration as well as set forth in the remarks filed by applicants is sufficient to overcome the examiner's rejection of claims 76, 77, 79 and 80 under 35 USC 112, first paragraph for lacking enablement. Applicants state "Applicant simply seeks an opportunity to provide the Office with the information it needs to fully understand the significance of Applicant's data. Withdrawal of finality would provide Applicant with that further opportunity...Applicant should be given an opportunity to fully address the Office's questions and to rebut the Office's doubts about the scope of Applicant's invention....Applicant should not be cut off in mid-stream. Applicant seeks an opportunity to resume these discussions...Thus, by making the Office Action final after the filing of only one substantive response by Applicant, the Office has effectively foreclosed Applicant's ability to adequately address all of the questions presently raised by the Office."

Applicants further seek the opportunity to rebut the new rejection of claims 76, 77, 79 and 80 for anticipation by Jacob et al. which was provided by applicant in the IDS filed on July 2, 2007: "Applicant should not be denied a full opportunity to respond to this new ground of rejection.

For this reason as well, Applicant respectfully requests withdrawal of finality of the present Office Action.” It is pointed out that only claims 76, 77 and 80 were rejected by the examiner as being anticipated by Jacob et al.; claim 79 was not included in the rejection.

Applicants essentially argue that prosecution in the case should go on indefinitely until a time that the examiner agrees with applicant’s opinions and finds the examined claims allowable; however, matters involving the finality of Office actions are governed by the MPEP. Such rules with regard to making Office actions final contribute to the overall goal of expedited patent prosecution:

The MPEP § 706.07 recites:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. *However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.*

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; Ex parte Hoogendam, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm’r Pat. 1939) emphasis added

Pertaining to the rejection of claims 76, 77 and 80 in the final Office action, applicant readily admits that the IDS submitted on July 2, 2007 contained the Jacob et al. reference which the examiner used to newly reject claims 76, 77 and 80 in the final Office action.

The MPEP § 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). *Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner.* emphasis added

Thus, the new ground of rejection set forth by the examiner in the final Office action was necessitated by the filing of the IDS on July 2, 2007. The examiner properly made final the Office action of September 13, 2007 according to the provisions of MPEP § 706.07. Additionally, there is no new rejection of record in the final Office action which was *not*

necessitated by Applicant's amendments, or *not* necessitated by the submission of an IDS by Applicant.

Further, while Applicants may not agree with the examiner's opinion of facts submitted on record with regard to the rejection over claims 76, 77, 79 and 80, the examiner provided ample, detailed reasons for maintaining this rejection. It is therefore deemed that there is a *clear issue for appeal* between the examiner and Applicants regarding the status of the claimed invention and reasons why the claims are currently rejected. Applicants are reminded of the right to the Appeal process concerning substantive issues involving the rejection of claims; see 37 CFR 1.191.

Accordingly, applicants' arguments are not persuasive that the final Office action issued September 13, 2007 was premature and the finality of the Office action will not be withdrawn.

DECISION

The petition is **DENIED**.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



John LeGuyader
Director, Technology Center 1600